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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,528	07/10/2003	Nigel Howard Julian Brown	AUS920030295US1	3557
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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER KARDOS, NEIL R	
			ART UNIT 3623	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeeiplaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/617,528	<b>Applicant(s)</b> BROWN ET AL.	
	<b>Examiner</b> Neil R. Kardos	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

This is a **NON-FINAL** Office Action on the merits in response to the request for continued examination filed on December 18, 2008. Claims 8-20 have been cancelled. Claims 1 and 5 have been amended. Currently, claims 1-7 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2008 has been entered.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Response to Amendment***

Applicant's amendments have been acknowledged. New grounds of rejection are presented below.

#### ***Claim Objections***

Claims 1-7 are objected to because of the following informalities:

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Claim 1: On line 16, claim 1 recites "responsive to determining that the intended used is conducting a self-assessment." In this limitation, "used" should be replaced with "use."

On lines 6-7, claim 1 recites "wherein assessment data is stored separately from assessment business logic." It is unclear whether the "assessment data" refers to "assessment business logic" or "self-assessment" data. For examination purposes, Examiner will construe "assessment data" as "self-assessment" data.

Claims 2 and 5: Claims 2 and 5 each recite "the data" (claim 2 recites it once and claim 5 recites it twice). It is not clear what data "the data" refers to. For examination purposes, Examiner will construe "the data" as "self-assessment" data.

Claims 2-7: Dependent claims 2-7 are rejected for failing to remedy the deficiencies of the claims from which they depend.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 1: Claim 1 is directed toward the statutory category of a process. In order for a claimed process to be patentable subject matter under 35 U.S.C. § 101, it must either: (1) be tied to a particular machine, or (2) transform a particular article to a different state or thing. *See In*

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*Re Bilski*, 88 U.S.P.Q.2d 1385 (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method/process is not patentable subject matter under § 101. Thus, to qualify as a statutory process under § 101, the claim should positively recite the machine to which it is tied (e.g. by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g. by identifying the material that is being changed to a different state). Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson*, 409 U.S. at 71-72. Thus, incidental physical limitations such as insignificant extra-solution activity and field of use limitations are not sufficient to convert an otherwise ineligible process into a statutory one.

Here, the claimed process fails to meet the above requirements for patentability under § 101 because it is not tied to a particular machine and does not transform underlying subject matter. Although the claim preamble recites that the method is “in a data processing system,” this is merely an incidental physical limitation that is insufficient to tie the claimed process to a particular machine.

Claims 2-7: Dependent claims 2-7 are rejected for failing to remedy the deficiencies of the claims from which they depend.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffor (US 2002/0173999) in view of MacDonald (US 2004/0068429), and further in view of Nandigama (US 2004/0010441).**

Claim 1: Griffor discloses a method in a data processing system for providing a consulting assessment environment, the method comprising:

- determining an intended use for the consulting assessment environment, wherein the intended use is one of defining assessment business logic (see ¶ 15, disclosing recording and structuring information produced by the definition phase of the organizational consulting process; ¶ 18, disclosing decomposing an organization; ¶ 19, disclosing a definitional stage and an organizational framework; ¶ 20, disclosing "business rules logic"; ¶ 21, disclosing specification tables constructed during the definitional phase of the consulting process; ¶ 23 et seq., disclosing specification tables; ¶ 51, disclosing an organizational definition) and conducting a self-assessment (see ¶ 16, disclosing an assessment of an organization to align the organization with its purpose; ¶ 19, disclosing determining success based on actual performance; ¶ 21, disclosing storing performance data; ¶ 22, disclosing allowing participants to give feedback on their individual performance), wherein defining assessment business logic is performed by a consultant (see above-cited sections; figure 2), wherein conducting a self-assessment is performed by the consultant or a client (see above-cited sections; figure 2), and wherein assessment

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data is stored separately from assessment business logic (see figure 3: item 64, disclosing an organizational performance database, and items 62-63, disclosing action rules and specification tables databases that store business logic; ¶ 6, disclosing separate databases for logic and performance; ¶¶ 20-21);

- responsive to determining that the intended use is defining assessment business logic, defining a data template, an assessment framework template, a suggested actions template, and a report template to provide the assessment business logic for multiple types of assessments for assessing businesses (see sections cited below);
- responsive to determining that the intended use is conducting a self-assessment, receiving data about a business through a questionnaire (see ¶¶ 17-18, disclosing determining the organization's goals, etc.; ¶ 23 et seq., disclosing gathering information generated during the definition phase; ¶¶ 28-31; ¶ 77; figure 2: items 1-4);
- responsive to receiving data about the business, computing at least one assessment score based on formulas and rules encoded in the assessment framework template (see ¶ 19, disclosing quantitatively measuring the importance of deliverables; figure 5, depicting relative value and total value; various figures disclosing point values; ¶¶ 41-50; ¶ 79; ¶ 82)
- responsive to computing the at least one assessment score, determining an appropriate action based on the at least one assessment score and the suggested actions template encoded with business-related domain knowledge that defines

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- actions to achieve desired states of business (see ¶¶ 19 and 21, disclosing actions rules used to maintain alignment between performance and goals; ¶ 22, disclosing action rule module that provides actions to be taken to help achieve organizational goals; ¶ 50, disclosing constructing action rules based on weights; ¶¶ 65-66; ¶ 82)
- reporting results of the assessment data based on the at least one assessment score and the appropriate action in accordance with the report template, wherein the data template, the assessment framework template, and the suggested actions template encode business-related domain knowledge including at least one of best practices, business consultant expertise, and business goals (see ¶¶ 54-58, disclosing a management module which provides reports to management; ¶¶ 59-64, disclosing a participant module which provides reports to workers; ¶¶ 72-80).

It is not explicitly clear whether Griffor discloses the claimed "templates" for storing data. MacDonald discloses a similar consulting system for strategic performance management that uses templates in the form of Microsoft Excel spreadsheets (see ¶ 36). It would have been obvious to one of ordinary skill in the art at the time the invention was made to record the information of Griffor in the templates of MacDonald. One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Further, Griffor does not explicitly disclose wherein the questionnaire is defined by the data template encoded with business-related domain knowledge of business practices. Nandigama discloses this limitation (see figure 5). Furthermore, Examiner takes Official Notice that it was well-known in the art at the time the invention was made to store questions in a



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template. It would have been obvious to one of ordinary skill in the art at the time the invention was made to define the questions asked by Griffor according to a template (such as that in Nandigama or those known in the art). One of ordinary skill in the art would have been motivated to do so for the benefit of efficiencies gained by storing information in reusable templates.

Griffor does not explicitly disclose wherein proprietary information and trade secrets are encoded into the data template, the assessment framework template, the suggested actions template, and the report template. However, these limitations are not sufficient to distinguish the claimed invention over the prior art because Griffor manipulates data in the same way as the claimed invention. In other words, the recited method steps would be performed in the same manner regardless of whether or not proprietary information and trade secrets are encoded into the templates. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art. *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* 2106.

Griffor does not explicitly disclose wherein the proprietary information and the trade secrets of the consulting assessment environment are accessible to the consultant and are made inaccessible to clients using a hiding feature. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to limit access to confidential data. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to hide confidential data from clients when performing the method of Griffor. One of ordinary skill in the art would have been motivated to do so for the benefit of increased security. Furthermore,

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Examiner notes that Applicant has failed to traverse Examiner's Official Notice, which was originally set forth in the previous Office action. Therefore, the above findings of Official Notice are taken to be admitted prior art. See MPEP § 2144.03 (C).

Examiner also notes that MacDonald and Nandigama also disclose many of the above limitations that Griffor has been shown to disclose.

Claim 2: Griffor discloses:

- determining the current state of the business based on the data (see ¶ 4, disclosing actual performance; ¶¶ 15-16; ¶ 77);
- identifying a desired state for the business using the assessment framework template and the suggested actions template (see ¶ 4, disclosing organizational goals; ¶¶ 15-16; ¶ 77); and
- performing a gap analysis between the current state of the business and the desired state of the business to determine appropriate action to achieve the desired state for the business (see ¶ 4, disclosing aligning performance and goals; ¶¶ 15-16; ¶ 77, disclosing determining the gaps between performance and vision-required tasks).

Claim 3: The cited references do not explicitly disclose identifying benefits and risks based on the at least one assessment score and the appropriate action. Examiner takes Official Notice that it was well-known in the art at the time the invention was made to perform cost/benefit or risk/benefit analyses. It would have been obvious to one of ordinary skill in the

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art at the time the invention was made to perform a risk/benefit analysis on the proposed action of Griffor. One of ordinary skill in the art would have been motivated to do so for the benefit of making a more informed decision.

Claim 4: Griffor discloses consolidating portions of the results together for further analysis. (see various figures, which include consolidated results and scores).

Claim 5: Griffor discloses providing an interface for the client to conduct the self-assessment to gather the data about the business, wherein the data is used to determine a current state of the business, and wherein automated data synthesis is performed to relate the current state of the business to a desired state in real time. (see figure 3: item 52, disclosing a GUI).

Claim 6: Griffor discloses wherein the data template includes at least one of interview questions, weighing factors (see ¶¶ 21, 44-49), desired states (see ¶¶ 16-19, 21), benefit descriptions, risk descriptions, suggested actions (see ¶¶ 21-22), cost areas, and terminology. Furthermore, Examiner notes that the claimed contents of the data template amount to non-functional descriptive material that do not functionally alter the claimed method. The recited method steps would be performed in the same manner regardless of what data is contained in the data template. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art. *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Claim 7: Griffor discloses wherein the assessment framework template includes at least one of scoring information (see ¶¶ 26, 41-49), calculations (see *id.*), suggested actions logic (see ¶¶ 21-22), benefit and risk logic, user feedback, and user input). Furthermore, Examiner notes that the claimed contents of the assessment framework template amount to non-functional descriptive material that do not functionally alter the claimed method. The recited method steps would be performed in the same manner regardless of what data is contained in the assessment framework template. Thus, the prior art and the claimed invention have identical structure and the claimed descriptive material is insufficient to distinguish the claimed invention over the prior art. *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* 2106.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Neil R. Kardos  
Examiner  
Art Unit 3623

NRK  
2/7/09  
/Jonathan G. Sterrett/  
Primary Examiner, Art Unit 3623